

REMARKS/ARGUMENTS

Claims 1-18 are pending in the present application. Claims 14-18 have been withdrawn from consideration through a Restriction Requirement. Claims 2 and 11 are objected because of informalities. Applicant has amended Claims 1, 2 and 11 to address the informalities and Applicant asserts the objection is overcome. Claims 1-13 are objected to under 35 U.S.C. § 103(a) as being unpatentable over Pierpont (U.S. Patent No. 5,484,412) in view of Crittenden, et al. (U.S. Patent No. 4,988,356). Applicant disagrees with the Examiner's conclusions and respectfully requests reconsideration of the rejection.

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pierpont in view of Crittenden. Applicant first asserts that a *prima facie* case of obviousness is not provided because a combination of the prior art references would not result in the invention as claimed in independent claims 1 and 9. Independent claim 1 requires in part "an elongated treatment catheter extending through an opening in said tubular wall of said anchoring catheter and having a distal end". Similarly amended claim 9 in part requires "a treatment catheter extending through an opening in the tubular wall of the anchoring catheter". As recognized by the Examiner, Pierpont fails to disclose a treatment catheter that extends through an opening in the tubular wall of the anchoring catheter. (Office Action, page 3). As a result the Examiner uses Crittenden to cure Pierpont.

Crittenden does not cure Pierpont as Crittenden does not teach an elongated treatment catheter extending through an opening in a tubular wall of an anchoring catheter. Instead Crittenden teaches a guide wire 14 that extends through a slit 28 of a catheter 10. (Col. 4, lines 57, through Col. 5, line

9). Specifically catheter 10 is a balloon dilatation catheter used in angioplasty procedures. (Col. 4, lines 38-42). Additionally this catheter 10 is formed with the longitudinal slit 28. (Col. 4, lines 57-62). Thus Crittenden does not teach a treatment catheter 10 extending through an opening in another catheter and instead teaches a guide wire extending through an opening in a treatment catheter. Therefore each and every limitation of claims 1 and 9 would not result from a combination of the references and a *prima facie* case of obviousness has not been presented. Consequently Applicant asserts the obviousness rejection should be withdrawn.

Applicant additionally asserts claims 1 and 9 are non-obvious because there would be no reason to combine the Pierpont and Crittenden references. The Supreme Court recently warned against rigid and preventative rules in regard to teaching, suggestion and motivation to combine that may deny the use of common sense. (See KSR Int'l Company v. Teleflex, Inc., 127 S.Ct. 1727, 82 U.S.P.Q. 2d, 1385 (2007)). Still a fact finder should be aware of the distortion caused by hindsight bias and arguments relying on *ex post facto* reasoning. Id. "Rejections on obvious grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (Quoting In re Kahn, 441 F.3rd 977, 988) (Fed.Cir. 2006)).

Applicant asserts that upon review of the prior art references there is neither an explicit or inherent reason for combining the references. Specifically the Pierpont reference is directed toward improving the advancement of the balloon dilatation catheter. (Pierpont, Col. 1, line 62 through Col. 2, line 5). Crittenden is not concerned with the advancement of a

balloon dilatation catheter. Instead Crittenden is directed towards avoiding a long exchange guide wire, exchanging guide wires within a catheter, minimizing tension load on a guide wire and minimizing the risk of guide wire entanglement in procedures when multiple guide wires are used. (Crittenden, Col. 2, line 3-16).

Thus the Pierpont reference solves the problem of advancing a balloon dilatation treatment catheter whereas the Crittenden reference solves problems associated with guide wires. Therefore, Applicant asserts that at the time the invention was made that Pierpont as one skilled in the art would not have a reason to consider the Crittenden reference as Pierpont was not interested in solving problems associated with a guide wire. Similarly, at the time the invention was made Crittenden as one skilled in the art did not have a reason to improve advancement of a balloon dilatation catheter as Crittenden was not interested in problems regarding the advancement of a balloon dilatation treatment catheter. Thus Applicant asserts that there is not an explicit reason within the Pierpont or Crittenden references that would cause one skilled in the art to combine the references to arrive at the claimed invention.

Additionally Applicant asserts there are not inherent teachings within the references or within the skill of the art that would provide a reason to combine the guide wire improvement of Crittenden with the treatment catheter improvement of Pierpont. Specifically, Pierpont's solution added extra structural support to the balloon dilatation treatment catheter. (See Pierpont Col. 1 line 51 - Col. 2 line 11 and Col. 3 lines 33-40). In contrast the solution of Crittenden inherently weakens the balloon dilatation catheter structure 10 while by placing a slit 28 therein. (See

Crittenden (Col. 4 lines 57-62). Thus the inherent teachings of the references would not cause one skilled in the art to combine the references to arrive at the claimed invention.

Consequently there is not an explicit or inherent reason for combining the references and Applicant asserts the combination is not obvious. Therefore Applicant respectfully requests allowance of the claims.

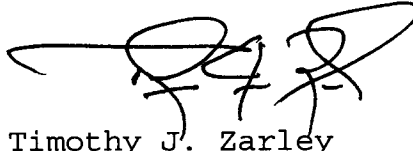
In light of the above arguments, Applicant asserts that independent claims 1 and 9 present allowable subject matter and Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. § 103 on these claims. Additionally claims 2-8 depend on claim 1 and claims 10-13 depend on claim 9 and for at least this reason Applicant also considers these claims in allowable form.

CONCLUSION

If any issues remain that may be expeditiously addressed in a telephone interview, the Examiner is encouraged to telephone the undersigned at 515/558-0200.

All fees or extensions of time believed to be due in connection with this response are attached hereto; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-2098.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'T. Zarley', with a stylized flourish extending from the end.

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